

**REMARKS**

Claims 1-22 are pending in the present application. Applicants have amended Claim 20 herewith to correct a typographical error, and entry of this amendment after final is requested to correct such typographical error in order to place this case in condition for allowance or better form for appeal. Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 102, Anticipation**

The Examiner rejected Claims 1, 3-5, 7, 9-11, 13, 15-17 and 19-22 under 35 U.S.C. § 102 as being anticipated by Moen et al., U.S. Patent 5,864,604. This rejection is respectfully traversed.

Generally speaking, the present invention is directed to a real-time billing intervention system, whereby in response to receiving a request for a document, a party associated with the document is charged for subsequent network access to the network by the client. This is different from the teachings of the cited Moen reference for at least two different reasons. First, the 3<sup>rd</sup> party charging of the present invention is done in *real-time* ("in response to receiving the request"), whereas the cited reference teaches a *prepaid* billing scheme. Secondly, the charges of the present invention are with respect to *network access*, whereas the cited reference teaches charges associated with the *requested content*.

Specifically with respect to Claim 1, Applicants show that the cited reference does not teach the claimed feature of "*in response to receiving the request, charging a party associated with the document, in lieu of the client who otherwise is charged network charges for their network access, for subsequent network access to the network by the client*". As can be seen, (1) the charging of a party associated with a document (for which a request has been made) is *responsive to receiving the request*, and (2) this charging is with respect to *subsequent network access to the network*. In contrast, Moen teaches a prepaid scheme to a given site address, whereby a user is permitted to make a call of a preset message limit to the site address (Moen Abstract; Col. 3, lines 2-6; Col. 8, lines 30-33). In response to the end user accessing the site address, a predetermined

message or access to data is provided in accordance with the preset message limit (Col. 3, lines 14-16). Once the session is terminated, the prepaid account of the sponsor is debited accordingly (Col. 6, line 25). There is simply no charging *responsive to the user request*, as claimed, which advantageously provides for real-time billing of *subsequent access*. This is in contrast to Moen's prepaid technique, which is similar to a prepaid calling card where money to use the card is paid up-front, prior to actually being able to use the card to make a phone call. It is only *after* a sponsor has purchased subsequent usage for a site address that an end user is allowed access to the site address, by distributing to the end user a user unit (after having pre-paid for subsequent usage) that allows such access (Figure 1, steps 12, 14, 16). This prepaid account is then debited after the session is terminated (Figure 1, step 20; Col. 6, line 25). There is no teaching of charging in response to receiving a request for document from a client, as claimed.

In addition, per Claim 1 the charging that is done is with respect to subsequent *network access*. The cited Moen reference teaches that the pre-paid charge is with respect to a *specific site address* (Moen Col. 3, lines 2-8). By analogy, the claimed invention is similar to charging for driving a vehicle on a toll road, whereas the teachings of the cited reference is similar to charging for entry into a specific building. Quite simply, charging for subsequent network access is very different from a charge for accessing a specific site address (which may or may not have network access charges associated therewith). Thus, Claim 1 is further shown to have claimed features not taught by the cited reference.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants have shown above that every element of the claimed invention is not identically shown in a single reference, and thus Claim 1 is not anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 3-5 for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 3, such claim is a further refinement of the real-time network access charges that are directed to subsequent use of the network after receiving a request for a document. In particular, Claim 3 recites that these network access charges

are associated with a wireless link access to the network. The cited reference teaches that the charges are associated with a given site address. While the reference does allude to use of a cellular network to access the given site address, the prepaid charges are not with respect to this cellular network access, but rather are with respect to the specific access to the specific site address. This can clearly be seen at Moen Col. 6, lines 14-27, where it states:

An end user's computer dials an Internet Service Provider (ISP) via a CSN using a dialup analog phone line, Integrated Services Digital Network (ISDN), or leased lines. Having logged onto the ISP, the end user points his browser to a particular site address by specifying the URL, or clicking on a hyperlink pointing to the site address. Upon connecting to the desired site address, the end user must enter the PIN provided in the user unit. Verification of the PIN allows entry into the restricted areas (i.e. pages) in that site. The end user may be allowed one entry into such area only, a number of entries, timed entry, or an entry based on data throughput. After each entry, the allotted credit is decremented. The predetermined message can be viewed interactively online, or the message can be downloaded from the site address for viewing at a subsequent time.

As can be seen, the user is not prompted to enter the requisite PIN to access the restricted site address until *after* the network connection to the ISP has been completed and the end user points his browser to a particular site address. The reference is silent as to any charges that may occur for accessing the ISP network. This clearly shows that the PIN authorization is not with respect to network charges such as those associated with accessing an ISP, but rather are merely charges associated with access to the specific site address. Thus, even though the reference makes mention of use of a cellular phone to access the internet, the prepaid charges as taught by Moen are not associated with such wireless link access, as the prepaid charges are only debited when a particular site address is accessed, not when the network itself is accessed. Thus, Claim 3 (and similarly for dependent Claims 4 and 5) is further shown to not be anticipated by the cited reference.

Applicants traverse the rejection of Claims 7, 9-11, 13 and 15-17 for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claims 9-11 and 15-17 for similar reasons to the further reasons given above with respect to Claim 3.

With respect to Claim 19, and similar to reasons given above with respect to Claim 1, Applicants show that the cited reference does not teach charging a server party for access to a network, in lieu of charging a client party who otherwise is charged for the client party's access to the network, when the client party accesses network content of the server party. As can be seen, accessing the network and accessing network content are both recited in this claim, meaning they are not the same thing but rather different. When the client party accesses network content, a server party is charged for *access to the network*. Thus, real-time 3<sup>rd</sup> party billing intervention for network access is advantageously provided by the invention recited in Claim 19. In contrast, the cited reference teaches *pre-payment of content access*. Thus, Claim 19 is shown to not be anticipated by the cited reference.

Applicants initially traverse the rejection of Claim 20 for reasons given above with respect to Claim 19 (of which Claim 20 depends upon). Applicants further traverse the rejection of Claim 20 for similar reasons to those given above with respect to Claim 3.

With respect to Claim 21, Applicants show that the cited reference does not teach the claimed steps of monitoring network traffic of a sender by an intervenor, and *responsive to* a determination that the sender is sending a request for information associated with the receiver, changing network access billing of the sender to instead bill the receiver for the sender's *network access*. Again, this claimed feature advantageously provides real-time third party billing intervention for network access, as the network is actively monitored and the billing is changed responsive to such monitoring, and in particular the billing is changed responsive to a determination that the sender is sending a request for information. The cited reference teaches a pre-paid billing scheme for access to a specific site address.

Applicants initially traverse the rejection of Claim 22 for reasons given above with respect to Claim 21 (of which Claim 22 depends upon). Applicants further traverse the rejection of Claim 22 for similar reasons to those given above with respect to Claim 3.

Therefore, the rejection of Claims 1, 3-5, 7, 9-11, 13, 15-17 and 19-22 under 35 U.S.C. § 102 has been overcome.

## II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 2, 6, 8, 12, 14 and 18 under 35 U.S.C. § 103 as being unpatentable over Moen et al., U.S. Patent 5,864,604 in view of Suzuki, U.S. Patent 6,493,763. This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 2, 6, 8, 12, 14 and 18 for reasons given above with respect to Claim 1.

Further with respect to Claim 2, it is respectfully urged that the cited Suzuki reference is directed to a content accounting system, and has nothing to do with network access charges. For example, Suzuki states at Col. 5, lines 24-27:

"Upon the user thus enjoying the work in which the CM was inserted, an amount of money *according to the video on demand work* is accounted to the sponsor by the accounting unit 25."

This distinction is similar to the differences in charges that are made if a person subscribes to a cable TV or satellite provider. There is a monthly fee associated with the network access itself, which is typically a flat fee irrespective of what, if any, programming the viewer actually watches. If the user watches particular programming, such as pay-per-view movies, sports, or other content, these charges are with respect to the particular programming that is ordered by the customer for viewing. This content-specific charge is different from the underlying network access charge. Suzuki's teachings are directed to content charges, and not network access charges, and thus the teachings in general are very different from the claimed subject matter recited in Claim 2, which is with respect to network access charges.

In particular, the cited Suzuki reference does not teach or suggest *discontinuing charging the party for subsequent network access*, as specifically recited in Claim 2. The Examiner cites Suzuki teaching at Col. 5, lines 20-37 as teaching this claimed feature. Applicants show that to the contrary, this passage teaches that either a sponsor or a user is charged for requested content. There is no teaching or suggestion of discontinuing

charging the party for subsequent network access, as claimed. To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). As all of the claim limitations are not taught or suggested by the cited references, it is shown that a *prima facie* case of obviousness has not been made with respect to Claim 2. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Thus, Applicants show that they are entitled to a patent at least with respect to Claim 2, as a *prima facie* case of obviousness has not been made with respect to Claim 2.

With respect to Claim 6, Applicants show that neither cited reference teaches or suggests the claimed feature of "after a pre-determined time interval has elapsed, discontinuing charging the party for the subsequent network charges associated with subsequent access to the network by the client". The Examiner acknowledges that the cited Moen reference is lacking in this regard, but states that Suzuki fills this void at Col. 5, lines 20-37. Applicants initially traverse this assertion for similar reasons to those given above with respect to Claim 2, and show that Suzuki's charging scheme is with respect to content, and not *network charges* associated with access to a network. Nor does Suzuki teach discontinuance of charging the party (associated with the document/content) *after a pre-determined time interval has elapsed*. The user is either charged or not charged for content depending upon whether they select to view a CM (commercial). The sponsor is either charged or not charged for content depending upon whether the user selects to view the CM. There is no charging and then discontinuing of charging after a pre-determined time interval has elapsed.

Similarly, there would be no motivation to modify the teachings of Suzuki to include such time-based discontinuance of charging, as content based charging is done based on the content itself and is not related to time. As an analogy, when viewing a video-on-demand movie on cable TV, a user can pause the movie numerous times without incurring additional charges for viewing such movie. This is because the charges are associated with the content itself, and are not associated with any underlying network access charges which may be time-sensitive. Because content-related charging is time-

neutral, there would have been no motivation to modify the teachings of Suzuki to include a time-factor in Suzuki's charging scheme. Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is simply no suggestion or motivation in the cited Suzuki reference to modify a content specific charging scheme to include some type of time element for discontinuance of charging.

Nor would there have been any motivation to modify the teachings of the cited Moen reference in accordance with Claim 6, as Moen teaches a pre-paid system where a sponsor pays up front before allowing any content access by a user, and thus there would be no need or other motivation to discontinue *charging* the party associated with the document/content after a predetermined time interval has elapsed. Again, this goes to the fundamental difference of an up-front, pre-paid system (as taught by Moen) and a real-time charging system (as per the claimed invention). Thus, it is further shown that Claim 6 is not obvious in view of the cited references.

Applicants further traverse the rejection of Claims 8 and 14 for similar reasons to the further reasons given above with respect to Claim 2.

Applicants further traverse the rejection of Claims 12 and 18 for similar reasons to the further reasons given above with respect to Claim 6.

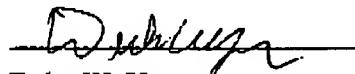
Therefore, the rejection of Claims 2, 6, 8, 12, 14 and 18 under 35 U.S.C. § 103 has been overcome.

**III. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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